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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,077	02/10/1999	DAVID J. LADD	1298/OE486	8370

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EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 10/04/2004

241

Please find below and/or attached an Office communication concerning this application or proceeding.

24

## Office Action Summary

**Application No.**

09/248,077

**Applicant(s)**

LADD, DAVID J.

**Examiner**

Salad E Abdullahi

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-16,27-30 and 35-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-16,27-30 and 35-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>23</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/26/2004 has been entered.

2. Applicant's arguments with regard to claims 12-16, 27-30 and 35-59 have been fully considered but are not persuasive for the following reasons.

(a) with regard to claims 12 and 27, applicant alleges the claims require that audio representation is to a voice mailbox remote from the wireless portable device further alleging A there is no teaching or suggestion in the prior art of record to send travel the directions in text format to the mailbox remote from the wireless unit, in the first place, so that funk's system can translate the text message into a voice mail@ (see page 12, lines 3-11).

In response to applicant's argument with respect to (a). Examiner respectfully disagrees. First, Behr's system discloses for receiving an information request (travel direction) from wireless portable device (variety of mobile units 20, 18), accessing an informational database (map database 72) and retrieving a text information in response to the request. Behr is silent regarding processing the text information into text-to-voice to generate an audio representation and transmitting the audio to voice mailbox remote

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from the wireless portable device. Funk fills this gap by disclosing a system which provides personalized service to respective users including the step of receiving an information from a source 100 (database), translating the information with text-voice-processor and delivers generated voice to user's voice mail box as requested by the user (col. 3, lines 43 to col. 4, line 24). Furthermore, Funk's system (see fig. 1) shows the voice mail service 110 is remote from the end-user system 114. Hence, one having ordinary skill in the art at the time of the invention would have readily recognized the advantage of Funk's teaching to the Behr's system as it provides a translation service as well as customized or personalized information via email or fax or voice mail based on the user's choice (see col. 1, lines 58-61).

(b) with regard to claims 36 and 44, applicant alleges the prior art of record does not teach or suggest fail to make any mention of a call taker who manually enters data (see page 13, lines 3-8). Examiner respectfully disagrees, because Behr teaches the base unit 12 includes means of receiving cellular telephone call and a operator unit which inputs data into the system (see col. 1, lines 38-42 and col. 6, lines 55-60).

( c ) with regard to claims 49 and 55, applicant alleges office action fails to address the travel direction (information request ) is received as a voice form. Examiner disagrees, because the base of unit of Behr includes an I/O interface for coupling the base unit with plurality of communication medium including wireless, wire line, cellular telephone system with plurality of mobile units (see col. 6, lines 55-60 and col. 7, lines 55 to col. 8, line 36).

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Funk also teaches receiving a message in variety of forms including a voice form (see col. 6, lines 30-37).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12-16, 27-30 and 35-58, are rejected under 35 U.S.C. 103(a) as being unpatentable over Behr et al U.S. Patent No. 5,543,789, in view of Funk U.S. Patent No. 5,793,497.

As per claims 12, discloses a method for communicating with a wireless information device comprising the steps:

- receiving an information request (route guidance or route direction), (see fig. 1, the abstract and col. 5, line 66 to col. 6, line 13);
- receiving a device identification from a wireless device ( to receive a response to the information request a device identification would have been obviously included with the information request for example it would have been obvious the remote unit (pager 20) to provide the base unit a device identification which should receive response to the information request) (see also col. 12, lines 24-37).
- accessing an informational database with the information request (see fig. 1, element 72);

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- receiving from the informational database text format information in response to the request (see abstract);

Behr does not explicitly disclose:

processing the text format with text-to-voice processor to generate an audio representation to the responsive information and sending the audio representation in mailbox remote from the wireless portable device.

Funk, discloses a messaging system, for providing a personalized or customized information delivery system via (email or voice mail or fax) including a translation facility (220) that provides subscriber services such as text-to-voice translation. The audio representation generated by the translation facility is further transmitted or stored in a subscriber voice mailbox (see figs. 1 and 2, elements 110, 220 and col. 3, line 36 to col. 4, line 56). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention presented with teaching of Funk to modify Behr et al to include the translation services as discloses by Funk, in order to provide customized or personalized information delivery via email or fax or voice mail based on the user's preferences (see col. 1, lines 58-61).

In considering 13, Behr discloses the method of claim 12, wherein the information request contains plurality of geographic locations and the responsive information comprises driving direction between locations (see col. 3, line 51-67).

In considering 14, Behr discloses the method of claim 13, wherein said information

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database is mapping database providing driving direction in response to a query containing a geographic location (see col. 3, line 51-67).

In considering claim 15, Behr discloses the method of claim 13, wherein said text format information comprises driving directions (see col. 3, line 51-67).

In considering claims 16, Funk discloses a system for accessing an informational database over a network, in particular the Internet obviously HTTP emulation the communications network through which the informational database is accessed includes Internet (see figs. 1 and 2, elements 110, 220 and col. 3, line 36 to col. 4, line 56).

As per claim 27, Behr discloses a system for communicating with voice mail box comprising the steps:

- a call center for accepting an information request (route guidance or route direction), and voice mail identification from wireless portable unit (see fig. 1, and col. 5, line 66 to col. 6, line 13);
- an interface for transmitting the information request to an informational database and for receiving responsive information back from the informational database (see also col. 12, lines 24-37).
- accessing an informational database with the information request (see fig. 1, element 72);

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- receiving from the informational database text format information in response to the request (see abstract);

Behr does not explicitly disclose:

text-to-voice processor receiving said responsive information in text format and providing responsive information in voice format and transmitter for providing said responsive information in the voice format to the voice mailbox, wherein the voice mailbox is remote from the wireless portable

Funk, discloses a messaging system, for providing a personalized or customized information delivery system via (email or voice mail or fax) including a translation facility (220) that provides subscriber services such as text-to-voice translation. The system includes a text-to-voice processor receiving said responsive information in text format and providing responsive information in voice format and transmitter for providing said responsive information in the voice format to the voice mailbox, wherein the voice mailbox is remote from the wireless portable (see figs. 1 and 2, elements 110, 220 and col. 3, line 36 to col. 4, line 56). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention presented with teaching of Funk to modify Behr to include the translation services as discloses by Funk, in order to provide customized or personalized information delivery via email or fax or voice mail based on the user's preferences (see col. 1, lines 58-61).

In considering claim 28, Behr discloses a system, wherein the interface comprises a computer server (see col. 3, line 46 and col. 4, lines 6-20).



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In considering claim 29, Behr discloses a system, wherein the interface comprises a computer server (see col. 3, line 46 and col. 4, lines 6-20).

In considering claims 30, Funk discloses a system for accessing an informational database over a network, in particular the Internet obviously HTTP emulation the communications network through which the informational database is accessed includes Internet (see figs. 1 and 2, elements 110, 220 and col. 3, line 36 to col. 4, line 56).

In considering claim 35, Funk discloses the method of claim 12, further comprising the steps of: recording the audio message in the mailbox (see col. 6, lines 30-45); and calling the voice mailbox using the wireless portable unit to retrieve the recorded audio representation(see col. 6, lines 30-45).

As per claims 36. The claim recites limitations analogous to those limitation recited in claims 12 and 27, further reciting: having a call taker manually enter information (see Behr col. 1, lines 38-42 and col. 6, lines 55-60, where an operator inputs data into the system receiving and where the base station is capable of receiving cellular telephone calls send by the mobile stations).

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In considering claims 37, Behr discloses the method according to claim 36, wherein the first information or the query includes an identifier, which uniquely identifies the portable device (see col. 12, lines 24-36).

In considering claim 38 Behr et al further discloses the method according to claim 36, wherein the first information includes plurality of geographic location addresses and the second information includes driving directions (see col. 11, lines 5-12).

In considering claim 39, Behr et al further the method according to claim 36, wherein the informational database is a mapping database and second information includes driving directions (see col. 11, lines 5-12).

In considering claim 42, Funk discloses the method according to claim 36, for accessing an informational database over a network, in particular the Internet obviously HTTP emulation the communications network through which the informational database is accessed includes Internet (see figs. 1 and 2, elements 110, 220 and col. 3, line 36 to col. 4, line 56).

In considering claim 43, Behr further discloses the method according to claim 36, the step of accessing the informational database occurs over a dedicated line (see fig.1).

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As per claim 44, The claims recite limitations analogous to those limitation recited in claims 12 and 27, further reciting: having a call taker manually enter information (see Behr col. 1, lines 38-42 and col. 6, lines 55-60, where an operator inputs data into the system receiving and where the base station is capable of receiving cellular telephone calls send by the mobile stations).

In considering claim 45, Behr discloses the system according to claim 44, wherein the first information includes destination address and unique identification associated with the person calling or portable wireless device(see col. 12, lines 24-36).

In considering claim 46, Behr further discloses the system according to claim 44, wherein the first information includes plurality of geographic location addresses and the second information includes driving directions (see col. 11, lines 5-12).

In considering claim 47, Behr discloses the system according to claim 44, wherein the informational database is a mapping database and second information includes driving directions (see col. 11, lines 5-12).

In considering claim 48, Funk discloses a system according claim 44, wherein said interface is connected to the internet in order to transmit data to, and receive data from the informational database (see figs. 1 and 2, elements 110, 220 and col. 3, line 36 to col. 4, line 56).

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5. As per claims 49 and 55. The claims recite limitations analogous to those limitation recited in claims 12 and 27, further reciting: receiving a voice call from a person desiring information (See Behr, see col. 6, lines 55-60 and col. 7, lines 55 to col. 8, line 36, where the base of unit of includes an I/O interface for coupling the base unit with plurality of communication medium including wireless, wire line, cellular telephone system with plurality of mobile units).

In considering claim 50, Behr discloses the method according to claim 49, wherein the first voice information includes destination address and unique identification associated with the person calling (see col. 12, lines 24-36).

In considering claims 51, Behr discloses the method according to claim 49, information includes destination address and unique identification associated with the person calling (see col. 12, lines 24-36).

In considering claim 52, Behr further discloses the method according to claim 49, wherein the first information includes plurality of geographic location addresses and the second information includes driving directions (see col. 11, lines 5-12).

In considering claim 53, Behr et al further discloses the method according to claim 49, informational database is a mapping database and second text information includes driving directions (see col. 11, lines 5-12).

In considering claims 54, Funk discloses the method according to claim 49, wherein said step of accessing the informational database occurs over the internet (see figs. 1 and 2, elements 110, 220 and col. 3, line 36 to col. 4, line 56).

In considering claim 56, Behr discloses the system according claim 55, wherein information includes destination address and unique identification associated with the person calling (see col. 12, lines 24-36).

In considering claim 57, Behr further discloses the system according claim 55, the wherein the first information includes plurality of geographic location addresses and the second information includes driving directions (see col. 11, lines 5-12).

In considering claim 58, Funk discloses a system according to claim 55, wherein said interface is connected to the internet in order to transmit data to and receive data from the informational database (see figs. 1 and 2, elements 110, 220 and col. 3, line 36 to col. 4, line 56).

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6. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Behr and Funk.

As per claim 59, Although, Behr and Funk disclose substantial features of the claimed invention, they are silent regarding: the wireless portable units (mobile units) include a cellular telephone.

However, utilizing cellular telephone would have been an obvious modification with the system of Behr and Funk. Furthermore, Behr's base unit includes an interface with cellular telephone system, which may interact with cellular telephone units. Additionally, Behr teaches mobile units may include other types mobile units (see col. 7, lines 36-54). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention provided the system of Behr and Funk to utilize cellular telephone set because a major advantage of cellular telephone is mobility it provides to the user when traveling.

### **CONCLUSION**

7. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 703-308-8441. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**


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Abdulahi Salad  
Examiner Au 2157  
9/30/2004